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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,630	12/14/2001	William R. Matz	36968/265389	9447

30314 7590 02/25/2003

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EXAMINER
OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/017,630	MATZ ET AL
	Examiner	Art Unit
	Jonathan Ouellette	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 December 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5, and 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawler (US 5,758,259)

3. As per independent Claims 1, 12, and 16, Lawler discloses a method for providing a tailored media content comprising: analyzing a subscriber attribute in a subscriber database, wherein said subscriber database comprises a media-content-access history of said subscriber; developing a media-content offering complementary to said subscriber attribute; delivering said media-content offering to said subscriber. (Abstract, Figs.3B-6, C1 L60-67, C2 L1-49, C5 L52-65, C7 L36-43, C9 L36-62, Claims 12-15).

4. As per Claim 5, Lawler discloses wherein said step of developing said media-content offering comprises analyzing an existing media-content offering (Abstract, Figs.3B-6, C1 L60-67, C2 L1-49, C5 L52-65, C7 L36-43, C9 L36-62, Claims 12-15).

5. As per Claims 11 and 15, Lawler discloses creating a marketing bundle, wherein said marketing bundle comprises a said media-content offering and a product (Abstract, Figs.3B-6, C1 L60-67, C2 L1-49, C5 L52-65, C7 L36-43, C9 L36-62, Claims 12-15).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2-4, 6, 7, and 17-20 are rejected under 35 U.S.C. 103 as being unpatentable over Lawler.

8. As per Claims 2, 3, 17, and 18, Lawler does not expressly show wherein said attribute comprises a purchase history of said subscriber or a demographic measure.

9. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method for providing a tailored media content would be performed regardless of the type of attribute used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the purchase history of said subscriber or the demographic measure as an attribute in the method for providing a tailored media content, because such an attribute does not functionally relate to the steps in the method claimed and because the subjective interpretation of the attribute does not patentably distinguish the claimed invention.

11. As per Claims 4 and 19, Lawler does not expressly show wherein said media-content-access history comprises a subscriber content-choice database.

12. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method for providing a tailored media content would be performed regardless of the type of media-content-access history used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

13. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a subscriber content-choice database as a media-content-access history in the method for providing a tailored media content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the media-content-access history does not patentably distinguish the claimed invention.

14. As per Claims 6, 7, and 20, Lawler does not expressly show wherein said media-content offering comprises a television program or a television-programming package.

15. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method for providing a tailored media content would be performed regardless of the type of media-content offering used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a television program or a television-programming package as the media-content offering in the method for providing a tailored media content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the media-content offering does not patentably distinguish the claimed invention.

17. Claims 8-10, 13, and 14 are rejected under 35 U.S.C. 103 as being obvious over Lawler.

18. As per Claims 8-10, 13, and 14, Lawler fails to distinctly disclose the steps of setting a price for said media-content offering, developing a direct marketing campaign complementary to said media-content offering, and developing an incentive plan complementary to said media-content offering (Abstract, Figs.3B-6, C1 L60-67, C2 L1-49, C5 L52-65, C7 L36-43, C9 L36-62, Claims 12-15).

19. However, these steps are obvious business strategies/techniques commonly used at the time the invention was made.

20. Furthermore, these steps can be accomplished completely through the use of the common business training/knowledge and require no additional apparatus described in the specification, which would have made the steps non-obvious to combine with the method described by Lawler, in order to create a method for providing a tailored media content, with the advantage of attracting customers using common business strategies/techniques.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

22. The following foreign patent is cited to show the best foreign prior art found by the examiner:

European Pat. No. EP 1162840 A2 to Wilson et al.

Wilson discloses a method and apparatus for delivering targeted assets to subscribers using communication media, wherein each subscriber has a set top box, the method comprising the steps of generating a profile of each subscriber at the set top box associated with the respective subscriber, broadcasting an asset to all subscribers along with target information; and delivering the asset only to subscribers whose profiles match the target information.

23. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

www.actv.com, Screen Print, 10/8/2000

ACTV.com discloses software used with digital television systems called "Individual Television," in which the software is used for creating interactive and instantly customized television content and advertising in response to viewer remote control entries or to stored demographic information.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

26. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo
February 19, 2003

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600